



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/028,011 | 12/21/2001 | Steven K. Lee | 2432 | 2625 |

7590 05/31/2005
 Beck & Tysver, P.L.L.C.
 Suite 100
 2900 Thomas Avenue S.
 Minneapolis, MN 55416

EXAMINER

CANGIALOSI, SALVATORE A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3621

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/028,011 | LEE, STEVEN K. | |
| | Examiner | Art Unit | |
| | Salvatore Cangialosi | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

HC

15

Art Unit: 3621

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 2-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Newby et al (5796829) in view of Throckmorton et al (5818441) alone or further in view of Owensby (6647257).

Regarding claim 2, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose means for conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which includes a gateway substantially as claimed. The differences between the above and the claimed invention is the use of the term decoding. It is noted that it is believed that the session key included in the wireless transmission(See Col/ 5, lines 50-67) are functionally equivalent to the hidden message. Throckmorton et al (See Fig.

Art Unit: 3621

2) show a wireless combined data stream with decoding. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Newby et al because the decoding and decryption are conventional functional equivalents with respect to the claim limitations. Regarding the interface limitations of claim 3, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which includes a gateway that is a functional equivalent of the claim limitations. Regarding the address limitations of claim 4, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding the unique address limitations of claim 5, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding claim 6, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose means for conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which includes a gateway substantially as claimed. The differences between the above and the claimed invention is the use of the term decoding. It is noted that it is believed that the session key included in the wireless transmission(See Col/ 5, lines 50-67) are functionally

Art Unit: 3621

equivalent to the hidden message. Throckmorton et al (See Fig. 2) show a wireless combined data stream with decoding. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Newby et al because the decoding and decryption are conventional functional equivalents with respect to the claim limitations. Regarding the control limitations of claim 7, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose conditional access in a wireless network by inserting a hidden data in a combined data stream which enables(therefore controls) the decoding(decryption) of the data stream which is a functional equivalent of the claim limitations. Regarding the unique address limitations of claim 8, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit which is a functional equivalent of the claim limitations. Regarding the key limitations of claim 9, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which is a functional equivalent of the claim limitations. Regarding the key limitations of claim 10, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which is a functional equivalent of the claim limitations.

Art Unit: 3621

Regarding the pay option limitations of claim 11, Owensby (see Fig. 4, Col. 21, lines 20-30) show a signal identifier for a mobile unit with no subsidy which is a functional equivalent of the claim limitations. Regarding the content limitations of claims 12-14, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which is a functional equivalent of the claim limitations.

Regarding the status limitations of claim 15, Owensby (see Fig. 4, Col. 21, lines 20-30) show a status identifiers for a mobile unit which is a functional equivalent of the claim limitations.

Regarding the unique address limitations of claim 16, Owensby (see Col. 1, lines 60-65) show a subscriber identifier for a mobile unit that is a functional equivalent of the claim limitations. Regarding the access limitations of claim 17, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding (decryption) of the data stream including a plurality of remote source providers which is a functional equivalent of the claim limitations. Regarding the pay option limitations of claim 18, Owensby (see Fig. 4, Col. 21, lines 20-30) show a signal identifier for a mobile unit with no subsidy which is a functional equivalent of the claim limitations. Regarding claim

Art Unit: 3621

10, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose a method for conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which includes a gateway substantially as claimed. The differences between the above and the claimed invention is the use of the term decoding and revenue subsidy. It is noted that it is believed that the session key included in the wireless transmission (See Col/ 5, lines 50-67) are functionally equivalent to the hidden message. Throckmorton et al (See Fig. 2) show a wireless combined data stream with decoding. Owensby (See abstract, Figs. 1-3, Col. 10, lines 30-50 claims 1, 21, and 33) show a method for subsidizing the cost of a wireless network by inserting a commercial advertisement in the data stream. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Newby et al because the decoding and decryption are conventional functional equivalents with respect to the claim limitations and because conditional access systems are always employed to generate revenue(i.e. satellite tv). Regarding claim 20, Newby et al (See abstract, Figs. 1-3, Col. 12, lines 40-65 claims 1-28) disclose means for conditional access in a wireless network by inserting a hidden data in a combined data stream which enables the decoding(decryption) of the data stream which includes a gateway substantially as claimed. The differences between the above and

Serial Number: 10/028,011

7

Art Unit: 3621

the claimed invention is the use of the term decoding. It is noted that it is believed that the session key included in the wireless transmission(See Col/ 5, lines 50-67) are functionally equivalent to the hidden message. Throckmorton et al (See Fig. 2) show a wireless combined data stream with decoding. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Newby et al because the decoding and decryption are conventional functional equivalents with respect to the claim limitations.

The applicants arguments are moot due the new rejection and reference.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Serial Number: 10/028,011

8

Art Unit: 3621


or faxed to (703)872-9306

Hand delivered responses should be brought to

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is (703) 306-5771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222